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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,394	03/30/2001	Joanne Chory	SALKINS.012CP1	8748

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EXAMINER

KEMMERER, ELIZABETH

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 12/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

9/17

Advisory Action

Application No.

09/823,394

Applicant(s)

CHORY ET AL.

Examiner

Elizabeth C. Kemmerer, Ph.D.

Art Unit

1646

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☒ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 11 and 12.

Claim(s) objected to: 4.

Claim(s) rejected: 1-3 and 6-10.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: (a) new issues: Claims 1 and 23 recite a polypeptide "or variants thereof". It is not clear if the claims are now directed to a compound (a single polypeptide or a single variant) or a composition (several variants). This raises a new issue under 35 U.S.C. § 112, 2nd paragraph. The issue could be resolved by amending "or variants thereof" to "or a variant thereof". Also, new claim 29 would necessitate a new grounds of rejection under 35 U.S.C. § 112, 1st paragraph, regarding enablement. The specification shows that the variant recited in claim 29 has virtually no brassinosteroid binding activity as required by the claim. New claims 29 and 30 recite specific variants that have not yet been searched, requiring further consideration and search. (b) new matter: The specification as originally filed does not support the variant recited in claim 30, and Applicant did not point to specific support for this variant in the specification as originally filed..

Continuation of 5. does NOT place the application in condition for allowance because: the scope of enablement rejection would be maintained for claims 1-3 and 6-10. The claims are not limited to variants which are point mutations. The specification does not disclose active variants with multiple mutations. The art indicates that there are additive effects of point mutations (Wells, 1990 Biochemistry 29:8509-8517, of record), establishing the unpredictability of such variants with multiple mutations.

Elizabeth C. Kemmerer

ELIZABETH KEMMERER
PRIMARY EXAMINER